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09/145,381	09/01/1998	TOM SAUTER	KTWO111889	5899

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EXAMINER

PHAN, HAU VAN

ART UNIT	PAPER NUMBER
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3618

24

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/145,381

Applicant(s)

SAUTER, TOM

Examiner

Hau V Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-21, 24-25, 27, 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-21, 24, 25, 27 and 29-34 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6-13 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____

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DETAILED ACTION

Acknowledgment

1. The request for continued examination filed on 12/4/2003 has been considered.
2. The request for reconsider filed on 12/4/2003 has been considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Oyen et al. (5,951,027).**

Oyen et al. in figures 4-4G disclose a shock absorbent in-line roller skate for an inline skate comprising a shoe portion (14) and plurality of wheels (16, 18, 20 and 21) capable of traversing a surface. The skate frame comprises an elongate first structural member having first and second sidewalls (56, 58) depending downwardly from a first upper surface. The lower ends of the sidewalls being spaced to receive wheels therebetween, and a flexible plastic (68), which is capable of vibration dampening formed with the sidewalls of the first structural member for absorbing at least a portion of the vibrational energy transmitted from the surface to the shoe portion when the skate

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traverses the surface. The vibration damping means comprise a contour portion (see figure 4B) of each of the first and second sidewalls of the first structural member. The contour portion has a predetermined cross sectional shape to permit the sidewalls to flex, thereby absorbing at least a portion of the vibrational energy associated with traversing the surface. Oyen et al. fail to show the flexible vibration damping means integrally formed with the sidewalls. As regards the integration of elements, where the essential elements are recited in the claims, the unity or diversity of the particular elements or parts are not seen to comprise an inventive concept (see *In re Lockhart*, 90 USPQ 214 (CCPA 1951)). The use of a one piece construction in place of a multiple piece assemblage has been held to be an engineering expedient (see *In re Larson* 144 USPQ 347 (CCPA 1965) and *In re Fridolph*, 50 CCPA 745, 89F.2d 509, 135 USPQ 319). Note, "integral" is defined as formed as a unit with another part.

5. Claim 1 is alternatively rejected under 35 U.S.C. 102(b) as being anticipated by Oyen et al. (5,951,027).

Oyen et al. in figures 4-4G disclose a shock absorbent in-line roller skate for an inline skate comprising a shoe portion (14) and plurality of wheels (16, 18, 20 and 21) capable of traversing a surface. The skate frame comprises an elongate first structural member having first and second sidewalls (56, 58) depending downwardly from a first upper surface. The lower ends of the sidewalls being spaced to receive wheels therebetween, and a flexible plastic (68), which is capable of vibration dampening integrally formed (noted the term "integrally" defined from Webster's is formed as a unit

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with another part) with the sidewalls of the first structural member for absorbing at least a portion of the vibrational energy transmitted from the surface to the shoe portion when the skate traverses the surface. The vibration damping means comprise a contour portion (see figure 4B) of each of the first and second sidewalls of the first structural member. The contour portion has a predetermined cross sectional shape to permit the sidewalls to flex, thereby absorbing at least a portion of the vibrational energy associated with traversing the surface.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oyen et al. as applied to claim 1 above, and in view of Malewicz (5,092,614).**

Oyen et al. disclose a vibration dampening means and a skate frame, but fail to show the skate frame in arcuate shaped.

Regarding claim 2, Malewicz further discloses that the vibration dampening means comprises a contoured portion (130, 160) of each have the first (32) and second (34) sidewalls of the first structured member (14). The contoured portion (160) has a predetermined cross-sectional shape to permit the sidewalls to flex (impliedly disclosed

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at col. 6, lines 1-15; Malewicz discloses a flexible, lightweight fiberglass polyamide frame) thereby absorbing at least a portion of the vibrational energy associated with traversing the surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the skate frame of Oyen et al. with skate frame having the contour portion as taught by Malewicz in order to have more flexibility on the vibration dampening means.

Regarding Claim 3, Malewicz further discloses that the cross-sectional shape of the first and second sidewalls is substantially arcuate (see fig 6) such that the contoured portion of the sidewalls flexes to absorb at least a portion of the vibrational energy.

Regarding claim 4, Malewicz further discloses that the arcuate cross-sectional shape of the first and second sidewalls is substantially C-Shaped in configuration (see fig 2), the arcuate cross-sectional shape having an upper end (200) spaced from a lower end (110) by a concave portion (136).

Regarding claim 5, Malewicz further discloses that the concave portion (136) of the first sidewall (32) faces the concave portion (166) of the second sidewall (34) in an opposed manner such that the first structural member (12) is tubular.

Allowable Subject Matter

8. Claims 14-21, 24-25, 27, 29-34 are allowed.

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9. Claims 6-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 12/4/2003 have been fully considered but they are not persuasive. Applicant's remark on page 3 that Oyen et al. fail to teach or suggest flexible vibration damping means integrally formed with the sidewalls. The examiner disagrees, because Oyen et al. in figure 4B disclose flexible vibration damping means integrally formed with the sidewalls (noted the term "integrally" defined by Webster's is formed as a unit with another part). The flexible vibration damping means (68) formed or press fitted with first and second sidewalls (56, 58) that can be considered as a unit.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hau V Phan whose telephone number is 703-308-2084. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on 703-308-0885. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP

Hauphan
2/5/04

HAUPHAN
PATENT EXAMINER